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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,024	02/15/2002	G. Ganga Raju	IHEAL-01063US1	5778
23910	7590	12/14/2006	EXAMINER AHMED, HASAN SYED	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			ART UNIT 1615	PAPER NUMBER

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/463,024

Applicant(s)

G. RAJU

Examiner

Hasan S. Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-27, 29 and 31-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-27, 29, and 31-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

- Receipt is acknowledged of applicant's amendments to the claims and remarks, which were filed on 29 September 2006.
- Rejections under 35 U.S.C. 112(1) over claims 26 and 27 are hereby withdrawn in light of the amended claims.
- Rejections under 35 U.S.C. 112(1) over claims 28-41 are hereby withdrawn in light of the amended claims.
- The statutory type and obviousness-type double patenting rejections are maintained.
- A new ground of rejection under 35 U.S.C. 103(a) is applied to claims 25-27 and 31-39.
- Claims 25-27, 29, and 31-41 remain rejected.

\* \* \* \* \*

### NEW REJECTION

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27 and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,612,039 ('039) in view of Clouatre et al ("The Diet and Health Benefits of HCA").

'039 teach a dietary supplementation composition comprising the calcium

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salt of Garcinia Cambogia-hydroxycitric acid extract (column 3, lines 5-14 and column 5, line 60 - column 6, line 29). According to '039, the Garcinia extract can be used to reduce appetite and assist in dietary control (column 3, lines 12-14 and column 5, lines 66-67). In terms of the dosage amount, about 750 mg may be administered to an individual prior to a meal (Claims 3-4). Since the compositions can be administered to an individual prior to breakfast, lunch, and dinner, it is the examiner's position that the compositions can be administered to an individual up to three times per day (Claims 3-5).

Although '039 teaches a hydroxycitric acid-based composition comprising calcium, it does not teach adding potassium to the weight loss composition.

Clouatre et al. ("The Diet and Health Benefits of HCA") suggest that potassium may augment the weight loss response of hydroxycitric acid (page 41). That is, it may be advantageous to combine potassium with hydroxycitric acid because such a combination could improve the weight loss capacity of hydroxycitric acid. Because, according to Clouatre et al, the addition of potassium to a composition can augment the weight loss effects of hydroxycitric acid, one of ordinary skill in the art would have been motivated to add potassium to the hydroxycitric acid-based composition advanced by '039. Based on the teachings of '039 together with Clouatre et al., there is a reasonable expectation that a composition comprising potassium, calcium, and hydroxycitric acid would be an effective weight loss composition. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add potassium to

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the calcium/hydroxycitric acid-based composition advanced by '039 in view of the teachings of Clouatre et al.

While neither '039, nor Clouatre et. al. explicitly teach the percentages of instant claims 25-27, it is the position of the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

Furthermore, the references are silent with respect to the properties of instant claims 35-37. Applicant's composition is the same as the prior art. It contains the same components in the same configuration. Properties are the same when the structure and composition are the same. Thus, burden shifts to applicant to show unexpected results, by declaration or otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed properties would have been present once the composition was employed in its intended use. *In re Best*, 195 USPQ 433.

\* \* \* \* \*

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**MAINTAINED REJECTIONS*****Double Patenting*****1. Statutory Type Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 25, 26, and 29 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3-5, 7-9, 12 of copending Application No.11/209429 ('429). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. '429 claims compositions comprising (1) hydroxycitric acid in the amount of approximately 55-65%, calcium in an amount of either 14 - 26% by weight or 9 - 13% by weight (depending on how the percentage by weight is calculated), potassium in an amount of either 24 - 40% by weight or, 9-20% by weight, or 14 - 18% by weight (depending on how the percentage by weight is calculated), or sodium in an amount of either 14 - 24% by weight or 5 - 12% by weight (depending on how the percentage by weight is calculated), and mixtures thereof. The above limitations are the same ones as set forth in the instant claims 25, 26, and 29.

**2. Obviousness-Type Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-32, 38-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 6, 10-11, 13-36 of copending Application No. 11/209429 ('429). Although the conflicting claims are not identical, they are not patentably distinct from each other because '429 claims compositions comprising (1) hydroxycitric acid in the amount of approximately 40-65%, calcium in an amount of either 14 - 26% by weight or 9 - 13% by weight (depending on how the percentage by weight is calculated), potassium in an amount of either 24 - 40% by weight or, 9-20% by weight, or 14 - 18% by weight (depending on how the percentage by weight is calculated), or sodium in an amount of either 14 - 24% by weight or 5 -12% by weight (depending on how the percentage by weight is calculated), and mixtures thereof. Like the instant claim set, the composition claimed by '429 can be used as a food product and is suitable for reducing body weight.

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. Because '429 claims a food product comprising hydroxycitric acid, calcium, and potassium or sodium, and claims that said product can be used to reduce body weight (claim 15, 26, 28), the examiner respectfully suggests that one of ordinary skill in the art at the time the invention was made would have the requisite motivation to claim a food composition comprising hydroxycitric acid, calcium, potassium, or sodium as well as a method of using said composition to reduce body weight. The expected result of such a combination would be an effective weight reducing food composition. As such, given the claims of '429, one of ordinary skill in the art at the time the invention was made would have the motivation to claim a food composition comprising hydroxycitric acid, calcium, potassium, or sodium as well as a method of using said composition to reduce body weight.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

\* \* \* \* \*

### ***Response to Arguments***

Applicant's arguments filed on 29 September 2006 have been fully considered and are partially persuasive.

### ***Withdrawn Rejections***

#### **35 U.S.C. 112(1)**

1. Rejections under 35 U.S.C. 112(1) over claims 26 and 27 are hereby withdrawn in light of the amended claims.



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2. Rejections under 35 U.S.C. 112(1) over claims 28-41 are hereby withdrawn in light of the amended claims.

*Maintained Rejections*

As noted above, the statutory double patenting rejection is not overcome by the cancelled claims. Furthermore, the obviousness-type double patenting rejection is not overcome by the amendments.

☆

**Correspondence**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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